

### **REMARKS**

Claims 1-16 remain pending in the present application. Claims 1, 4, 7, 10, 13 and 14 have been amended. Basis for the amendments can be found throughout the specification, claims and drawings as originally filed.

### **ELECTION OF SPECIES**

Applicants respectfully disagree with the Examiner's interpretation of Claim 1. Figures 1, 4 and 5 disclose an outer cylinder 18, a first inner cylinder 16 positioned inside of and coaxial with the outer cylinder 18. Down tube 32 is believed to meet the limitation of "a second inner cylinder" (a tube is a cylinder) positioned inside the outer cylinder and outside the first inner cylinder, the second inner cylinder (down tube 32) defining a first passage. Claim 10 does not define the second inner cylinder as being coaxial with anything and thus down tube 32 can be defined as the second inner cylinder. Reconsideration of the generic nature of Claim 10 is requested.

### **DRAWINGS**

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4). The drawings have been amended to overcome the objection. Withdrawal of the objection is respectfully requested.

### **REJECTION UNDER 35 U.S.C. § 112**

Claims 1, 2, 4-9, 14 and 15 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which Applicant regards as the invention. The claims have been amended to correct the issues identified by the Examiner as well as additional issues identified by the Applicants. Reconsideration of the rejection is respectfully requested.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1, 2, 4-6 and 13-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mizumukai, et al. (U.S. Pat. No. 4,561,524) in view of Eddy, Jr. (U.S. Pat. No. 4,682,675). Applicants respectfully traverse this rejection by the Examiner. The adjustable valve 50 defined by the Examiner does not provide “a variable flow resistance” to fluid flowing between the upper working chamber and the reserve chamber. Valve 50 is simply an on/off valve which controls fluid flow from the upper working chamber to the reserve chamber during a compression stroke. It does not provide a variable flow resistance. During an extension stroke, fluid flows past check valve 60 while valve 50 (valve spool 52 and passageways 66 and 68) is closed. (Column 3, line 45 – Column 4, line 10). During a compression stroke, check valve 60 is closed while valve 50 (valve spool 52 and passageways 66 and 68) is open. (Column 4, lines 11-31). There is no variable flow through valve 50, it is on or off. The variable flow and thus the damping characteristics are generated by variable orifice 40 in both compression and rebound.

The Examiner proposes adding Eddy, Jr. to Mizumukai, et al. to provide the missing element in Mizumukai, et al. of providing a variable flow resistance to fluid flow between the upper working chamber and the reserve chamber to an external signal. The Examiner justifies this combination by stating “in order to reduce stiffness of the

damper". As detailed above, valve 50 of Mizumukai, et al. is an on/off valve and utilizing a sensor in communication with valve 50 to reduce the stiffness of the shock absorber is not possible in Mizumukai, et al. because valve 50 does not control the damping characteristics, variable valve 40 does. Thus, any external signal for controlling damping characteristics for the shock absorber in Mizumukai, et al. must be in communication with rotary solenoid 42 not valve 50 as proposed by the Examiner.

Claims 1, 10, 13 and 16 have been amended to define the adjustable valve as defining damping characteristics for the damper by providing a variable flow resistance..." to better define the present invention.

Thus, Applicants believe Claims 1, 10, 13 and 16, as amended, patentably distinguish over the art of record. Likewise, Claims 2, 4-9, 11, 12, 14 and 15, which ultimately depend from one of these independent claims, are also believed to patentably distinguish over the art of record. Reconsideration of the rejection is respectfully requested.

#### **REJOINDER**

Applicants respectfully request the rejoinder of Claim 3 in addition to the examination of Claims 10-12 on their merits.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is

believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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### **AMENDMENTS TO THE DRAWINGS**

The attached "Replacement Sheet" of drawings includes changes to Figures 4 and 5. The attached "Replacement Sheet," which includes Figures 4 and 5, replaces the original sheet including Figures 4 and 5.

Figure 4, please relocate reference number 26.

Figure 5, please redirect the leader line for reference numeral 30.

Attachment: Replacement Sheet